

## PATENT

**C. REMARKS****1. Examiner Interview**

Applicants note with appreciation the telephonic interview conducted between Applicants' patent agent, Scott Schmok, and the Examiner on March 3, 2004. During the telephonic interview, Applicants' patent agent discussed the 102 reference (Tognazzini, U.S. Pat. No. 5,790,974) in comparison to Applicants' claimed invention. Applicants' patent agent emphasized that the intent of Applicants' claimed invention is to perform various automated tasks based upon a user's travel arrangements, such as canceling a user's mail delivery and/or changing voice mail messages. Applicants' patent agent averred that, in contrast, Tognazzini teaches the synchronization of calendar entries between a portable device (i.e. PDA) and a centralized calendar system (i.e. a central office). The Examiner and Applicants' patent agent discussed amending claim 1 by including the limitations of particular dependent claims into claim 1 in order for claim 1 to read clearly over the teachings of Tognazzini. This amendment has been incorporated into each of the independent claims 1, 18, and 28. While no agreement was reached regarding the claims, Applicants respectfully submit that, as explained in further detail below, the amendments made to claims 1, 18, and 28, place these claims in condition for allowance. In addition, Applicants respectfully request that the Examiner consider newly added claims 38-40 that are supported by Applicants' specification and include limitations that are clearly not found in Tognazzini. Furthermore, if Applicants' arguments traverse the rejections included in the Office Action then, upon performing another search, Applicants should either receive a Notice of Allowance or a second non-final office action depending on whether new art is found by the Examiner supporting further rejections.

**2. Summary**

Claims 1-37 are currently pending in the application. Claims 1, 18, and 28 are independent claims. Claims 1, 3-7, 10, 12, 14, 18, 20-22, 25, 27-28, 30-32, 35, and 37 have been amended. Claims 2, 11, 13, 16-17, 19, 24, 26, 29, 34, and 36 have been

## PATENT

cancelled. Claims 38-40 have been added. No new matter has been added. Reconsideration of the claims is respectfully requested.

**3. Claim Rejections 35 U.S.C. § 102**

Claims 1, 3, 18, 20, 27, 28, 30, and 37 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,790,974 to Tognazzini. Applicants respectfully traverse the rejections.

As discussed above, Applicants' invention differs from Tognazzini in that Applicants' invention performs automated actions based upon a user's travel arrangements, whereas Tognazzini synchronizes a calendar system and checks for schedule conflicts.

Specifically, the limitations set forth in Applicants' claim 1, as amended, include:

scheduling the travel arrangements using a computer system;

recording the scheduled travel arrangements on a nonvolatile storage device connected to the computer system; and

sending one or more automated requests corresponding to the travel arrangements from the computer system to one or more service agents, wherein at least one of the service agents are selected from the group consisting of a delivery service agent, a telephone system, an electronic calendar system, and a medical information system.

Applicants third element of claim 1 includes the limitation of "*sending one or more automated requests corresponding to the travel arrangements from the computer system to one or more service agents...*" Applicants' service agents are used to service automated requests corresponding to travel arrangements, such as package delivery changes, voice mail greeting changes, and medical information downloads corresponding to a user's travel destination, such as local hospital locations. In contrast,

## PATENT

Tognazzini's agents manage calendar entries and the synchronization of the calendar entries. Tognazzini teaches the use of two agents, one of which is a remote agent that is located on a portable device and the other of which is an office agent that is located at a central office. Specifically, Tognazzini teaches "*a personal calendaring system includ[ing] a portable calendaring system and a complementary office calendaring system each synchronizing calendar entries by two-way wireless transmission*" (Abstract, lines 1-4, emphasis added).

In order to clarify Applicants intention of service agents, Applicants have amended the third element of claim 1 to include the limitations that were included in Applicants' original claims 2, 7, 11, and 13. As such, Applicants have added to claim 1 the limitation of "*wherein at least one of the service agents are selected from the group consisting of a delivery service agent, a telephone system, an electronic calendar system, and a medical information system.*" Applicants' original claim 2 was rejected under 35 U.S.C. § 102 as being anticipated by Tognazzini. Applicants original claims 7, 11, and 13 were rejected under 35 U.S.C. § 103 by combining Tognazzini with additional references that are discussed in further detail below.

Regarding the limitations of original claim 2, Applicants' delivery service agent might include a parcel service, a post office, or a company mailroom (claims 4-6). The limitation of a service agent as being a delivery service agent was included in the original dependent claim 2, of which the Office Action rejected in light of Tognazzini stating that Tognazzini teaches a delivery service agent. However, the Office Action's reference is, in fact, in regards to Tognazzini's portable agent that uses a user's location to determine whether a conflict exists between two calendar entries. Specifically, Tognazzini states:

*"an agent generating a second calendar entry input by a user and identifying a second location, the agent identifying one of the first and second calendar entries as a next appointment entry and calculating an estimated travel time for the next appointment entry in response to the determined current location, the location of the next appointment entry, and the corresponding stored travel time information" (col. 15:38-45, emphasis added)*

## PATENT

It is clear that Tognazzini's agent is to manage a user's calander entries using estimated travel times between two appointments and, Tognazzini does not teach or suggest sending an automated request to a delivery service agent as claimed by Applicants.

The limitations of original claims 7, 11, and 13 were rejected under 35 U.S.C. § 103 by combining Tognazzini with additional references. Claim 7 was rejected under 35 U.S.C. § 103 as being unpatentable over Tognazzini in view of U.S. Pat. No. 6,076,121 to Levine (hereinafter "Levine"). Claim 11 was rejected under 35 U.S.C. § 103 as being unpatentable over Tognazzini in view of U.S. Pat. No. 5,790,974 to Alexander et. al. (hereinafter "Alexander"). Claim 13 was rejected under 35 U.S.C. § 103 as being unpatentable over Tognazzini in view of U.S. Pat. No. 5,995,939 to Berman (hereinafter "Berman"). While the § 103 claim rejections are traversed in detail below with respect to dependent claims that stand rejected under § 103, the following remarks address the allowability of the amended independent claims over Tognazzini in view of Levine, Alexander, and Berman.

Regarding claim 7, the Office Action asserts that Levine teaches the use of a telephone information system and combines Levine with Tognazzini in order to reject Applicants' claim 7. In general, Levine teaches a system and method to minimize the number of directory numbers (i.e. telephone numbers) that a user requires. Specifically, Levine teaches "addressing and translating address in a network..."[by adding a] "functional property code to each device a user employs" (Abstract, lines 2-6, emphasis added). Levine's functional property codes are used to distinguish a device's "type", such as a telephone or a fax machine, so that more than one device can use the same directory number, and a telephone call can be directed to a particular device using the device's functional property code.

Applicants assert that the Office Action fails to establish a prima facie case of obviousness under § 103 as set forth in § 103 and the MPEP. MPEP 2142 states that:

*"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the*

## PATENT

knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."

Applicants assert that there is no motivation to combine the teachings of Tognazzini with Levine. Levine's invention is used in a network where multiple devices exists that have multiple device types. Tognazzini operates in a two-way wireless environment with two devices, each of the same device type. Combining Levine with Levine adds complexity (i.e. a functional property code) and does not provide any added feature or benefit to Tognazzini since the functional property codes would be useless if used with Tognazzini. Therefore, since there is no motivation to combine Levine with Tognazzini, Applicants have traversed the rejection to original claim 7 and, therefore, claim 1 is allowable by adding the limitations of claim 7 into claim 1. Specifically, adding the limitation of a service agent as being a telephone information system places claim 1 in a condition of allowance based upon the cited references.

Regarding original claim 11, the Office Action asserts that Alexander teaches the use of an electronic calendar system and combines Alexander with Tognazzini in order to reject Applicants' original claim 11. Applicants respectfully assert that Applicants completed and reduced to practice Applicants' claimed invention before the filing date of Alexander. A declaration, pursuant to 37 C.F.R. § 1.131, has been duly executed by Applicant Newton James Smith and is included with this Response. Mr. Smith declares that Applicants' claimed invention was completed and reduced to practice prior to September 27, 2000. Exhibit "A" to Mr. Smith's declaration are IBM Invention Disclosure Forms that disclosed Applicants' claimed invention. This Disclosure was submitted to the IBM Intellectual Property Law Department in Austin, Texas prior to September 27, 2000. Mr. Smith's declaration under 37 C.F.R. § 1.131, therefore, removes the Alexander patent from consideration as prior art. Because, for the aforesaid reasons, the Alexander patent is not prior art with respect to Applicants' claimed

## PATENT

invention, Applicants respectfully assert that original claim 11 is allowable under 35 U.S.C. § 103(a). Therefore, claim 1 is allowable by adding the limitations of original claim 11 into claim 1. Specifically, adding the limitation of a service agent as being an electronic calendar system places claim 1 in a condition of allowance based upon the cited references.

Regarding original claim 13, the Office Action asserts that Berman teaches the use of a medical information system and combines Berman with Tognazzini in order to reject Applicants' original claim 13. Berman teaches that *"service requests, such as ordering a medical test or requesting authorization for a particular procedure, are prepared... and emailed to the sponsor system of an appropriate service provider" ... [in which the] request is fulfilled and the results emailed back"* (Abstract, lines 7-12, emphasis added). In order to perform Berman's invention, Berman teaches that *"a complete system... typically includes hundreds of client systems and dozens of sponsor system"* (col. 2: 53-55) and *"requires that a database of information, such as the identities of a roster of patients, be built up on the client system"* (col. 3: 6-8, emphasis added).

Applicants assert that there is no motivation to combine the teachings of Tognazzini with Berman. Berman's invention is targeted toward the *"health care industry [such as] a doctor's office... [for] order[ing] ... a specific blood test"* (col. 4:4-9). In contrast, as discussed above, Tognazzini uses a two-way wireless system to synchronize calendar entries. There is no commonality between Tognazzini and Berman and, thus, no motivation to combine. In addition, if Berman were combined with Tognazzini, the combination adds complexity (i.e. email messages) and does not provide any added feature or benefit to Tognazzini since the email messages do not assist in the synchronization of calendar entries. Therefore, since there is no motivation to combine Berman with Tognazzini, Applicants have traversed the rejection to original claim 13 and, claim 1 is allowable by adding the limitations of claim 13 into claim 1. Specifically, adding the limitation of a service agent as being a medical information system places claim 1 in a condition of allowance based upon the cited references.

## PATENT

Claim 18 as amended is an information handling system claim including the same limitations as set forth in amended claim 1, so rejections to claim 18 as amended are traversed for at least the same reasons set forth above for amended claim 1. Claim 28 as amended is a computer program product claim including the same limitations as set forth in claim 1 as amended, so the rejection to claim 28 as amended is traversed for the same reasons as amended claim 1.

In short, based upon Applicants' amended claims, the Tognazzini, Levine, Alexander, and Berman references, either alone or in combination with one another, are wholly inapplicable to Applicants' claimed invention and, therefore, respectfully request that the Examiner withdraw the rejections. Specifically, Applicants assert that by including the limitations of claim 2, 7, 11 and 13 into claim 1, including the limitations of claims 19, 22, 24, and 26 into claim 18, and including the limitations of claims 29, 32, 34, and 36 into claim 28, independent claims 1, 18, and 28, as well as their respective dependent claims, are in condition for allowance. Each of the remaining claims, 3-10, 12, 14-15, 20-23, 25, 27, 30-33, 35, and 37 each depend, directly or indirectly, on one of the allowable independent claims 1, 18, or 28. Therefore, claims 3-10, 12, 14-15, 20-23, 25, 27, 30-33, 35, and 37 are also allowable for at least the same reasons that the respective independent claims are allowable.

#### 4. Claim Rejections 35 U.S.C. § 103- Tognazzini in view of Levine

Claims 4-6, 7-10, 21-23, and 31-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tognazzini in view of Levine. Applicants respectfully traverse the rejections.

Claims 4-6 include limitations with respect to a delivery service agent as being a parcel service, a post office, and a company mailroom, respectively. As discussed above, Applicants assert that there is no motivation to combine the teachings of Tognazzini with Levine. Levine's invention is used in a network where multiple devices exist that have multiple device types. Levine, in a mail or parcel system, uses functional property codes *"to indicate which department, division, or which technical compatibility is desired at the destination..."* (col. 28: 51-53). Tognazzini operates in a two-way

## PATENT

wireless environment with two devices, each of the same device type, and synchronizes calendar entries. As discussed above, combining Levine with Tognazzini adds complexity (i.e. a functional property code to an address location) and does not provide any added feature or benefit to Tognazzini. Therefore, since there is no motivation to combine Levine with Tognazzini, Applicants have traversed the rejection to claims 4-6. Claim 21 is an information handling system claim that includes the same limitations as claim 4 and, therefore, is allowable for at least the same reasons as claim 4. Claim 31 is a computer program product claim that includes the same limitations as claim 4 and, therefore, is allowable for at least the same reasons as claim 4.

Claims 7-9 include limitations with respect to a service agent as being a telephone system and the limitations correspond to configuring a telephone registering with an email system. As discussed above, Applicants assert that there is no motivation to combine the teachings of Tognazzini with Levine. Levine, in a telephone system, uses functional property codes to direct telephone calls to a particular device type, such as a telephone or fax machine. As discussed above, combining Levine with Tognazzini adds complexity (i.e. a functional property code to a device type) and does not provide any added feature or benefit to Tognazzini. Therefore, since there is no motivation to combine Levine with Tognazzini, Applicants have traversed the rejection to claims 7-9. Claims 22 and 23 are information handling system claims that include the same limitations as claims 7 and 9, respectively, and therefore, are allowable for at least the same reasons as claims 7 and 9. Claims 32 and 33 are computer program product claims that include the same limitations as claims 7 and 9, respectively, and, therefore, are allowable for at least the same reasons as claims 7 and 9.

Regarding claim 10, the Office Action asserts that Levine teaches setting a backup contact name and receiving a predefined signal from a calling telephone. Applicants respectfully disagree with this assertion. Levine teaches the use of a "*crank back route setup... [which routes a call] to a temporary... destination, followed by a retraction of the call and a second call setup to a different destination.*" (col. 22:21-25). However, this process never involves the setting of a backup contact name as claimed by Applicants. Therefore, in addition to Applicants' assertion that there is no



## PATENT

motivation to combine Levine with Tognazzini, Levine combined with Tognazzini never teaches nor suggests, either alone or in combination with one another, setting of a backup contact name as claimed by Applicants. Therefore, Applicants have traversed the rejection to claim 10, and claim 10 is in condition for allowance based upon the cited art.

**5. Claim Rejections 35 U.S.C. § 103- Tognazzini in view of Alexander**

Claims 12, 25, and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tognazzini in view of Alexander. As discussed above, Applicants respectfully assert that Applicants completed and reduced to practice Applicants' claimed invention before the filing date of Alexander. A declaration, pursuant to 37 C.F.R. § 1.131, has been duly executed by Applicant Newton James Smith and is included with this Response. Mr. Smith declares that Applicants' claimed invention was completed and reduced to practice prior to September 27, 2000. Exhibit "A" to Mr. Smith's declaration are IBM Invention Disclosure Forms that disclosed Applicants' claimed invention. This Disclosure was submitted to the IBM Intellectual Property Law Department in Austin, Texas prior to September 27, 2000. Mr. Smith's declaration under 37 C.F.R. § 1.131, therefore, removes the Alexander patent from consideration as prior art. Because, for the aforesaid reasons, the Alexander patent is not prior art with respect to Applicants' claimed invention, Applicants respectfully assert that Claims 12, 25, and 35 are therefore allowable under 35 U.S.C. § 103(a).

**6. Claim Rejections 35 U.S.C. § 103- Tognazzini in view of Berman**

Claims 14-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tognazzini in view of Berman. Applicants respectfully traverse the rejections. As discussed above, Applicants assert that there is no motivation to combine Berman with Tognazzini. In addition, regarding claim 14, claim 14 adds the limitations of:

receiving the automated request at the medical information system; and

## PATENT

downloading destination related medical information to a computing device that is accessible by a user in response to the received request.

The Office Action asserts that Berman teaches downloading destination related medical information to a computing device that is accessible by a user. Applicants respectfully disagree with this assertion. Berman does not teach downloading destination information. Instead, Berman teaches sending an email message that includes service request fulfillment information. Specifically, the Office Action's reference states:

*"...comprising a database of e-mail addresses for said sponsor systems and further programmed to automatically retrieve the email address from said database for the sponsor system which fulfills the service request ..." (col. 12: 26-30, emphasis added)*

In light of the foregoing, it is evident that Berman does not teach or suggest Applicants' claimed invention as set forth in claim 14 and that the rejection of this claim has been traversed. Claim 27 is an information handling system claim that has been amended to include the same limitations as claim 14 and, therefore, is allowable for at least the same reasons as claim 14. Claim 37 is a computer program product claim that has been amended to include the same limitations as claim 14 and, therefore, is allowable for at least the same reasons as claim 14.

Claim 15 is dependent upon claim 1 and is therefore allowable for at least the reasons given above for claim 1.


**CONCLUSION**

As a result of the foregoing, it is asserted by Applicants that the amended claims in the Application are in condition for allowance, and Applicants respectfully request an early allowance of such claims.

## PATENT

Applicants respectfully request that the Examiner contact the Applicants' attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,

By   
Joseph T. Van Leeuwen  
Attorney for Applicants  
Registration No. 44,383  
Telephone: (512) 301-6738  
Facsimile: (512) 301-6742